

**Remarks**

By the foregoing Amendment, claims 1, 22, and 24 are amended. No new matter is added by this Amendment. Entry of the Amendment, and favorable consideration thereof, is earnestly requested.

The Examiner has rejected independent claim 1 under 35 U.S.C. §102(b) as anticipated by Ito, U.S. Patent No. 5,454,366.

The Examiner has rejected independent claims 1, 22, and 24 under 35 U.S.C. §102(b) as anticipated by Yabe, U.S. Patent No. 4,741,327.

Applicant respectfully requests reconsideration of these rejections in light of the foregoing amendments and the below remarks.

Neither Ito nor Yabe anticipates independent claims 1, 22, or 24, as amended, because all of the elements in these claims are not shown in either of these references. Specifically, each of the independent claims requires an image sensor that is transverse to the longitudinal axis of an endoscope shaft. Neither Ito nor Yabe disclose such an assembly, as both of these references disclose an image sensor that is parallel to the longitudinal axis of the shaft.

With respect to Ito, as shown most clearly in Figure 2 and explained at Col. 3, Ins. 43-49, the image sensor is parallel to the longitudinal axis of the endoscope shaft, and the prism 33 folds the optical axis of the incoming light to reflect it towards the light receiving surface 31a.

Similarly, with respect to Yabe, as shown most clearly in Figure 6, the image sensor 40 is parallel to the longitudinal axis of the endoscope shaft, and the prism 36 folds the optical path of the incoming light by ninety degrees. See also Col. 3, Ins. 7-11.

Additionally, Applicant submits that it would not have been obvious to modify the designs of Ito and Yabe in order to arrive at the presently claimed invention, for several reasons. First, Applicant notes that, in order for the claimed invention to be obvious over the prior art, there must be some suggestion or motivation in the reference to make the relevant modification. *In re Mills*, 916 F.2d 680, 682, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990) (Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so" in order for obviousness to exist); MPEP 2143.01. Here, there is simply no suggestion in the prior art that would suggest to one skilled in the art that the orientation of the image sensor, and thus, the assembly of the other optical components, should be changed in order to arrive at the presently claimed invention.

Additionally, Applicant submits that one skilled in the art would not be motivated to alter the Ito and Yabe designs in the ways necessary to arrive at the present


invention, as they relate to a fundamentally different kind of optical system. Ito and Yabe both relate to side-mounted distal imagers, which mount the image sensor parallel to the scope axis as a way of decreasing the diameter of the distal tip of the scope, and they utilize a reflecting element, such as a prism, for folding the optical path of the incoming light so that it impinges upon this side-mounted sensor. In order to arrive at the present invention, one would have to completely change the basic design of these side-mounted distal imagers, changing both the orientation of the sensor and the nature of the preceding optical element(s) that fold the optical path. Accordingly, Applicant respectfully submits that the necessary modifications are not obvious, as such would require changing the basic principle of operation of these prior art devices. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959) (proposed modification cannot change the principle of operation of prior art device).

Applicant submits that, in light of the amendment herein, generic claim 1 is allowable, and thus, withdrawn claims 6, 7, 10-12, and 16 are also allowable.

It is respectfully submitted that claims 1-8, 10-19, and 21-25, all of the claims remaining in the application, are in order for allowance, and early notice to that effect is respectfully requested.

Respectfully submitted,

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